REMARKS

In the Final Office Action dated May 1, 2009, the Examiner rejected claims 1, 8 and 15 under 35 USC 112, first paragraph as failing to comply with the written description requirement, rejected claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b) as anticipated by US Patent Publication No. 2004/0117315A1 to Cornuejols ("Cornuejols"), rejected claims 1-4, 6-11 and 13-21) under 35 U.S.C. 103(a) as being unpatentable over the combination of Lin et al. (US 6,122,663) ("Lin et al.") and Heckerman et al. (US 2004/00832270) ("Heckerman et al."), and rejected claims 3-4, 6, 10-11 and 17-19 under 35 U.S.C. 103(a) as being unpatentable over the combination of Cornuejols and Heckerman et al.

Claims 1, 8 and 15 have been amended. Claims 1-4, 6-11 and 13-21 are currently pending. No new matter has been introduced.

I. Rejection of Claims 1, 8 and 15 under 35 USC 112, first paragraph

The Examiner rejected claims 1, 8 and 15 under 35 USC 112, first paragraph as failing to comply with the written description requirement. The Examiner asserted that the limitation "while there is available memory for storing at least one additional record" was not adequately described in the specification to show that the applicant had possession of the claimed invention. Claims 1, 8 and 15 have been amended to state "without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored". Claim 1, currently states in part "and, in response to an instruction from a user, to instruct the processor to file one or more of the records with the database after the classification of the one or more of the records and upon filing one or more of records with the database, automatically instruct the processor to delete one or more of the records from the memory without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored." Claim 8 currently states in part " "automatically deleting one or more of the records from the remote computer without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored, upon filing one or more of the records the central database via a record management system stored on the remote computer." Claim 15 currently states in part "means for automatically deleting one or more of the records from the remote computer without regard as to whether there is available memory for

storing at least one additional record or the amount of time the one or more records has been stored, upon filing one or more of the records with the central database".

While it is true that the language "while there is available memory for storing at least one additional record" was not included in the written description as originally filed, this limitation, as well as the new limitation added by amendment to replace this limitation, is inherent in the specification as originally filed.

The limitation claimed not to be disclosed in the written description was added to distinguish the claims from Cornuejols. The Examiner, previously argued that Cornuejols inherently meets the limitation to "automatically instruct the processor to delete one or more of the additional records" by overwriting records when the allocated memory space is full. The Examiner now argues that Cornuejols disclosed the previous limitation by stating "when no transaction is detected, a site page trace is storred in permanent memory and automatically deleted as a function of permanent memory space which is available and/or allocated to the implementation of the invention method" (0124) or "when no transaction has been detected, according to the user setup or the default assistance software setup, either the record is deleted or it is stored an put on a list of recording with an indicator that allows it to be automatically deleted after a predetermined storage duration or according to the memory space available" (0243).

The originally filed written description of the present application described deleting additional records without reference to whether the was available memory or not and without determining whether a predetermined storage duration had lapsed. For example, referring to the published application for convenience, paragraph [0034] in referring to Figures 3 and 4, states: "In block 414, the electronic records management, classification and protection system 212 deletes the record and the associated property field from the remote computer 102. After block 414, the electronic records management, classification and protection system 212 returns to block 302." Unlike prior art cited by the Examiner in earlier office actions, there is no requirement that memory be full to delete the record or that a specified amount of time has passed. The limitation "automatically instruct the processor to delete one or more of the records from the memory without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored" found in claim 1, 8 and 15, as amended, is not met by a system or method that only deletes records when

memory becomes full. Nothing in the written description as originally filed required determining whether memory was available or whether a predetermined storage duration had elapsed before deleting the record. In the written description, the record is deleted after block 414 and prior to returning to block 302 to process additional records. Thus, though not depicted in the drawings, the original specification envisioned deleting the record from the remote database prior to looping back to process additional records. There was no step or process flow that required determining whether there was sufficient memory available to store more records or determining whether a record had been stored for more than a predetermined storage duration prior to the deleting the record step at block 414. One skilled in the art, reading the original specification would recognize that the applicant had possession of the claimed invention at the time the application was filed, because the written description describes deleting the record from memory before returning to block 302 without requiring that the amount of available memory be determined or determining whether a predetermined storage duration had passed.

The rejection of claims 1, 8 and 15 under 35 U.S.C. 112, first paragraph should be withdrawn.

II. Rejection of Claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b)

The Examiner has rejected claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b) as anticipated by US Patent Publication No. 2004/0117315A1 to Cornuejols ("Cornuejols"). It is respectfully submitted that claims 1-2, 7-9, 13-16 and 19-21 are not anticipated by Cornuejols because Cornuejols, does not teach all the limitations of Claims 1-2, 7-9, 13-16 and 19-21, in view of the limitations of claims 1, 8 and 15. For example, without limitation, Cornuejois does not teach does not teach automatically deleting one or more records without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored" as recited in claims 1, 8 and 15.

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference." MPEP § 2131 (citing Verdegual Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner relies upon the statement that "when no transaction is detected, a site page trace is stored in a permanent memory and automatically deleted as a function of the permanent memory

space which is available and or allocated to the implementation of the invention," for establishing that Cornuejols teaches the limitation of " automatically deleting one or more records while there is available memory for storing at least one additional record." The language cited by the Examiner can easily be interpreted as indicating that the "site page" (not a record stored in a database as that term is used in the specification) is only deleted when the memory space is full or after determining that a predetermined storage duration has lapsed. Such asserted deletion, if it in fact occurs, does not meet the limitation of deleting one or more records " without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored " as recited in claims 1, 8 and 15 as amended.

Therefore, it is respectfully requested that the rejection be withdrawn.

III. Rejection of Claims 1-4, 6-11, 13-21 under 35 USC 103(a)

The Examiner has rejected claims 1-4, 6-11, 13-21 under 35 USC 103(a) as obvious over Lin et al. in view of Heckerman et al. and rejected claims 3-4, 6, 10-11 and 17-19 under 35 U.S.C. 103(a) as being unpatentable over the combination of Cornuejols and Heckerman et al. (Lin et al., Heckerman etal. and Cornuejols are collectively referred to as the "References"). It is respectfully submitted that claims 1-4, 6-11, 13-21 are not rendered obvious by the References because the neither of the combinations of the References as suggested by the Examiner teach all the limitations of Claims 1-4, 6-11, 13-21 in view of the limitations of claims 1, 8 and 15 from one of which each of the rejected claims depend.

In order to establish a prima facie case of obviousness "all of the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981 (C.C.P.A. 1974). "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing In re Fine, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

a. Lin does not disclose storing a "record" in memory

The Examiner indicates that Lin teaches a memory in which a record is stored by indicating that :"Program monitor 4 may be distributed as pre-loaded software (comprising a set of executable instructions) resident in memory of a personal computer, such as a hard-disk of a

notebook computer" (col. 4, line 1-16). Software comprising executable instructions is not a "record" as such term is used in the specification.

b. None of the References teaches deleting a record "without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored."

In rejecting claims 1- 1-2, 7-9 and 13-16 and 19-21 as being anticipated by Cornuejols, the Examiner asserted that Cornuejols teaches deleting records, but as indicated above, that deletion only occurs when allocated memory is full or after a determination that a predetermined storage duration has lapsed. The Examiner states that Lin et al. inherently teaches deleting the records from memory when the memory is full and explicitly teaches all of the other limitations of the claims, except classifying a record, which is taught by Heckerman et al. Repeatedly in paragraph 5, the Examiner indicated that he asserts that "when the remote data is filled with one or more file, the program monitor will delete one or more record from local (memory)." Such asserted deletion, if it in fact occurs, does not meet the limitation of deleting one or more records "without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored" as recited in claims 1, 8 and 15 as amended. None of the References, either alone or in combination, teach or suggest all of the limitations of the independent claims from which the rejected claims depend as Cornuejols, Lin et al. and Heckerman et al. do not teach or suggest the limitation of deleting one or more records " without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored " as recited in claims 1, 8 and 15, as amended.

Therefore, it is respectfully requested that the rejection be withdrawn.

CONCLUSION

For at least all of the foregoing reasons, it is respectfully submitted that claims 1-4, 6-11 and 13-21 are allowable. Favorable reconsideration and allowance of this Application is therefore respectfully requested. Applicants hereby request pursuant to 37 CFR 1.136(a) a three month extension of time to and including November 2, 2009, (November 1, 2009 having fallen

on a Sunday) rendering this response timely upon the granting of the extension of time. The fee for the three month extension of time, along with the fee for filing a Request for Continued Examination are being paid electronically by credit card concurrent with the filing of the Request for Continued Examination and this amendment. The Director is hereby authorized to charge any other fees which may be required, or credit any overpayment, to Deposit Account Number 09-0007. If applicants have inadvertently overlooked the need to petition for any additional extension of time or to pay an additional fee, Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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